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AET 3A/10/27/03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket No.: ATM-2244

Applicants : Wilfried JUD et al.  
Serial No. : 09/505,713  
Filed : February 17, 2000  
Title : STERILIZABLE COMPOSITE FILM

Art Unit: 1773

Examiner: M. Jackson

**APPEAL BRIEF**

Mail Stop-Appeal Brief-Patents  
Commissioner for Patents  
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Sir or Madame:

Appellants have appealed, and continue to appeal, to the Board Of Patent Appeals And Interferences from the final rejections by the Examiner of Claims 38 to 53. Appellants submit this appeal brief in support of appellants' appeal. Accordingly, appellants request reversal of the final rejections of Claims 38 to 53.

**(1) REAL PARTY IN INTEREST**

This application is a CPA of U.S.S.N. 09/505,713, that was assigned by the appellants to Alcan Technology & Management Ltd., a corporation of Switzerland, that is directly or indirectly owned and controlled by Alcan, a corporation of Canada.

**(2) RELATED APPEALS AND INTERFERENCES**

Appellants, the assignee and the undersigned attorney do not know of any other appeals or interferences that will directly affect or be affected by or have a bearing on the decision of the Board in the pending appeal.

### **(3) STATUS OF CLAIMS**

Claims 1 to 37 have been cancelled. Claims 38 to 53 have been appealed.

### **(4) STATUS OF AMENDMENTS**

The amendment after final was filed on April 23, 2003, but it did not contain any amendments to the claims, specification or drawings. The Examiner acted on the amendment after final via the Advisory Action of May 7, 2003.

### **(5) SUMMARY OF INVENTION**

Appellants' claimed invention involves a sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer (page 1, lines 3 and 4). The composite film has a layer structure containing one on top of the other in the following sequence (page 1, lines 30 and 31):

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layer (page 1, lines 33 to 35);

(b) a metal foil having a thickness of 5 to 100  $\mu\text{m}$  (page 1, line 35, and page 2, line 20); and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film (page 2, lines 1 and 2) having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer (page 5, lines 34 and 35). The first polypropylene is directly bonded to metal foil (b) or is bonded to metal foil (b) by means of a bonding

agent layer or a laminate adhesive layer (page 6, lines 5 to 7 and 18 to 20, page 7, lines 20 to 25, and page 10, lines 34 to 37), and, optionally, a primer layer is on at least one surface of metal foil (b) (page 2, lines 29 and 30).

#### **(6) ISSUES**

The issues presented for review are:

(1) Whether or not Claims 38 to 53 are unpatentable under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,589,275 (Breitler et al.).

(2) Whether or not Claims 38 to 53 are unpatentable under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,589,275 (Breitler et al.) in view of Ullmann's Encyclopedia of Industrial Chemistry (Ullmann).

The Examiner attached a copy of Muggli (U.S. Patent No. 5,968,663) to the Advisory Action of March 25, 2002 and relied on Muggli apparently in conjunction with both the Section 102(b) and Section 103(a) rejections. The Examiner has not included Muggli in the statement of either the Section 102(b) or Section 103(a) rejection. If the Examiner is relying on Muggli in either or both rejections, the Examiner should have recited Muggli in the statement of either or both rejections. Appellants do not know if Muggli is or is not part of either or both rejections. The Examiner repeated recitation of Muggli in the Office Action (Final) of February 24, 2003 and the Advisory Action of May 7, 2003.

#### **(7) GROUPING OF CLAIMS**

As regards the rejections of Claims 38 to 53 under 35 U.S.C. 102(b) and 35 U.S.C. 103(a), appellants state that for each such rejections (issues), the claims of

Group a (i.e., Claims 38 to 45 and 47 to 50), the claims of Group b (i.e., Claim 46), the claims of Group c (i.e., Claim 51) and the claims of Group d (i.e., Claims 52 to 54) do not stand or fall together.

#### **(8) REMARKS**

Before addressing the two issues for review in detail, appellants have set out a short discussion of the disclosure of Breitler et al., that is one of the major points of disagreement between appellants and the Examiner.

Appellants' claimed invention involves a sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer. The composite film has a layer structure containing one on top of the other in the following sequence:

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layer;

(b) a metal foil having a thickness of 5 to 100  $\mu\text{m}$ ; and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer. The first polypropylene is directly bonded to metal foil (b) or is bonded to metal foil (b) by means of a bonding agent layer or a laminate adhesive layer, and, optionally, a primer layer is on at least one surface of metal foil (b).

The Examiner has incorrectly contended that column 4 of Breitler et al. discloses appellants' second functional layer (c).

The disclosure in column 4 of Breitler et al., when taken in context with the entire disclosure of such patent, refers to a sealable layer on one or both sides of its composite material (and not to a sealable layer on both sides of a polyamide layer of said composite material). Appellants have presented below an analysis of column 4 and its meaning in the context of the whole disclosure of Breitler et al. and the wording in such column. Appellants have also presented court and Board decisions on it being in error to take portions of a prior art reference out of context. Further, appellants have presented quotations from documents from the prosecution/examination of Breitler et al. to support appellants' position.

### **The First Issue**

The first issue is whether or not Claims 38 to 53 are unpatentable under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,589,275 (Breitler et al.). Appellants contend that none of Claims 38 to 53 are anticipated by Breitler et al.

As stated in Chisum, Donald S., "Patents", (Ref. 37-2/91), at page 3-6.1, "The standard for lack of novelty, that is, 'anticipation', is one of strict identity."

Admissions and assertions by the Examiner in the record show that none of appellants' claims are anticipated by Breitler et al.

The remarks under the Section 103(a) (obviousness) rejection in the Office Action of December 19, 2001, include the following:

“Though Breitler et al. discloses all of the layers, layer materials and layer thickness as instantly claimed, Breitler et al. does not specifically limit the invention to the specific composite film combination as instantly claimed, however, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize any of the structures disclosed by Breitler et al. selecting from the disclosed materials taught by Breitler et al. based on the desired film properties for a particular end use, and further to utilize routine experimentation to determine the optimum thickness of the individual layers given that layer thickness is a result-effective variable affecting the barrier, mechanical, adhesion and sealing properties of the resulting composite based on the desired end use of the packaging composite taught by Breitler et al.”

[Emphasis supplied] [page 4]

This sounds like Section 103(a) language. Section 102(b) does not involve one ordinarily skilled in the art and does not allow one ordinarily skilled in the art to “utilize routine experimentation” to arrive at appellants’ claimed invention. The Office Actions of September 4, 2002, and February 24, 2003 relied upon the reasons stated in the Office Action of December 19, 2001.

As discussed above in the Section (6), the Examiner recited Muggli (U.S. Patent No. 5,968,663) in the Office Action (Final) of February 24, 2003 (and in two of the Advisory Actions including the last one). Page 4 of the Final Office Action stated:

“..., and further notes that her interpretation **is consistent** with what is understood in the packaging art, note specifically, the attached Muggli (U.S.

Patent No. 5,968,663, commonly owned to Alusuisse Technology &

Management) which also utilizes the same language as the commonly assigned Breitler et al. and further exemplifies polyethylene/polypropylene “sealable layers” (c, c<sup>1</sup>, e, and e<sup>1</sup>) on both sides of the plastic layers (d and d<sup>1</sup>), which are present on both sides of a central metal layer (a) (Abstract; Col. 3, line 42-Col. 4, line 2; Col. 4, lines 57-8.)” [Emphasis supplied]

If Breitler et al. definitively shows polypropylene layers on both sides of a central metal layer, why the use of the second reference, i.e., Muggli, to show (or supposedly to further exemplify) the same thing? Muggli is not being used to explain the disclosure of Breitler et al., but instead is an incorrect attempt to insert into Breitler, by supposed way of further exemplification, that which is not in Breitler et al.

Anticipation must be found in one, and only one, prior art reference. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 USPQ 2d 1001, (CAFC 1991), states:

“It is sometimes appropriate to consider extrinsic evidence to explain the disclosure of a reference. Such factual elaboration is necessarily of limited scope and probative value, for a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference: a finding that is not supportable if it is necessary to prove facts beyond those disclosed in the reference in order to meet the claim limitations. The role of extrinsic evidence is to educate the decision-maker to what the reference meant to

persons of ordinary skill in the field of the invention, not to fill gaps in the reference.” [Emphasis supplied] [Page 1010]

The Examiner has wandered into the domain of Section 103(a).

**Regarding independent Claim 38:**

Under Section 102(b) the burden of proof is upon the Examiner and the Examiner has not carried that burden in the case at bar. Ex parte Levy, 17 USPQ 2d 1461, (BPAI 1991), states:

“..., the initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner.” [Emphasis supplied] [Pages 1463 and 1464]

One of the main issues is whether Breitler et al., in column 4, lines 9 to 44, particularly lines 36 to 44, discloses:

- (1) an outerlying sealable (polypropylene) layer on either or both sides of the composite material; or
- (2) a sealable (polypropylene) layer on either or both sides of each polyamide layer (of the composite).

Analysis of the disclosure of Breitler et al. clearly shows that column 4 thereof deals with an outerlying sealable layer on either or both sides of the composite material.

The Patent Office’s position that column 4 of Breitler et al. deals with the polyamide layers (instead of the composite material) is in error.

The Patent Office has incorrectly taken portions of column 4 of



Breitler et al. out of context and has misanalyzed such disclosure. The context of Breitler et al. is that Breitler et al. is dealing with the composite material.

Throughout all of Breitler et al., the context is the composite material of their invention. When Breitler et al. speaks of “on one or both sides”, Breitler et al. is only speaking of the composite material.

The C.A.F.C. in In re Wright, 9 USPQ2d 1649, (1989), stated:

“We have carefully read every word of the Macaulay specification, paying particular attention to the passages relied on by the examiner, the board, and the Solicitor. \*\*\* We also conclude that the PTO’s attempt to show the contrary consists of taking statements wholly out of context, and giving them meanings they would not have had to one skilled in the art having no knowledge of appellant’s invention, or to anyone else who can read the specification with understanding.” [Emphasis supplied] [Page 1652]

The C.A.F.C. in Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. 230 U.S.P.Q. 416, 419-420, (1986), stated:

“The court also engaged in improper hindsight analysis to conclude the ‘814 patent would have been obvious. \*\*\*.”

“Barnes-Hind selected a single line out of the Caddell specification to support the above assertion: \*\*\*. This statement, however, was improperly taken out of context. As the former Court of Customs and Patent Appeals held:

It is impermissible within the framework of section 103 to

pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

*In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391,393 (CCPA 1965);  
*see also In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774,778 (CCPA 1975).”

“A full appreciation of Caddell’s statement requires consideration of the immediately following sentences in the same paragraph and the paragraph after that. Viewed in that context, it is apparent that \*\*\*. \*\*\* A complete reading demonstrates quite clearly that \*\*\*. The district court improperly viewed an isolated line in Caddell in light of the teaching of the ‘814 patent to hold for obviousness. This is improper hindsight analysis.”

“The district court also failed to consider the Caddell reference in its entirety \*\*\*. \*\*\*.” [Emphasis supplied]

The C.A.F.C. in *In re Evanega et al.*, 4 USPQ 2d 1249, 1251, (1987), stated:

“When read together and in context, \*\*\*. \*\*\* Instead, the entirety of Schuurs suggests that \*\*\*. *See Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ 2d 1593, 1597, *cert. denied*, 107 S.Ct. 2187 (1987) (in determining obviousness, a prior patent must be considered in its entirety).

Thus, we conclude that the board erred in determining that Schuurs established a prima facie case.”

The context of all the disclosure of Breitler et al. is the composite material of their invention. Breitler et al., for example states:

“The invention relates to a metal-plastic composite material \*\*\*.” [Emphasis supplied] [Col. 1, lines 6 and 7]

“The object of the present invention is to provide a metal-plastic composite material \*\*\*.” [Emphasis supplied]  
[Col. 2, lines 25 and 26]

“The objective is achieved by way of the invention in the form of a \*\*\* composite material \*\*\*.” [Emphasis supplied]  
[Col. 2, lines 29 to 31]

“The composite material \*\*\*.” [Abstract, first line]

The portion of column 4 of Breitler et al. relied upon by the Patent Office clearly deals with sealable layers located on the outer sides of the composite material. The context is entirely in terms of the composite material. There is no teaching of a sealing layer between a polyamide layer and the metal layer in the text in lines 3 to 45 of column 4 of Breitler et al., which reads as follows:

“The plastic layers on both sides of the metal layer of the composite according to the invention \*\*\*.”

“The plastic layers on both sides of the metal layer, in particular the polyamide-based thermoplastics may additionally, and independent of each other, be provided with an outer lying sealable layer and/or a barrier layer of thermoplastics.”

"The composite according to the invention may also feature a sealing layer or sealable layer on one or both sides."

"The composite material according to the present invention forms a composite containing plastic film that, in order to extend the range of properties, may be coated with one or more layers of material such as e.g. plastic films."

"Sealable layers are e.g. sealable films deposited e.g. via adhesives that contain or are free of solvents, or water-based adhesive systems, applied by extrusion lamination or lamination coating. Sealable films may contain or consist of e.g. LLDPE, LDPE, MDPE, HDPE, polypropylene, polyethylene-terephthalate or polyolefin-based isomers. Ionomers or ionomer-containing polymers with typical properties of ionomers may be thermoplastic copolymers of olefin with carboxyl-containing monomers, a part of which are present as free carboxyl groups and the remainder bonded to metal cations so that some transverse cross-linking is achieved. Polyethylene-based ionomers are known under the trade name Surlyn. Sealable films may be 6 to 100  $\mu\text{m}$ . Furthermore, one or more layers e.g. 1 to 10  $\mu\text{m}$  thick, of a sealing coating or hot-sealing coating, for example, may be deposited on the plastic film composite."

"A single or double-sided sealable composite is obtained by single or double-sided coextrusion of the plastic layers with e.g. a polypropylene/polyethylene copolymer."

“In that connection it is useful for the plastic layers to contain or comprise of a polyamide-based thermoplastic and at least one a polyamide-based thermoplastic to feature a sealing layer on at least one side i.e. each layer of polyamide-based thermoplastic may be covered with a sealable layer on one or both sides, independent of the other layers.” [Emphasis supplied]

All references to sealing layers in such text are exclusively to sealing layers, located on the outer surfaces of the composite material, i.e., on the outer surface of the plastic layers of the composite material.

Lines 36 to 45 of column 4 of Breitler et al. recites “\*\*\* with a sealable layer on one or both sides, \*\*\*” This statement refers to the sides of the composite material (and not to the polyamide layers) as shown by the language of lines 36 and 39 and the overall context of usage in Breitler et al. This is further confirmed by usage of such language elsewhere in Breitler et al.

Breitler et al., in column 5, line 49, to column 6, line 14, states:

“Typical arrangements of the layers in composites according to the invention include for example:

- a) a middle layer of aluminium of thickness e.g. 8 to 80  $\mu\text{m}$ , preferably 40 to 70  $\mu\text{m}$  and in particular 45 to 60  $\mu\text{m}$ , and on each side of the aluminium layer
- b) and b') a layer of adhesive coating and/or bonding agent having a thickness of 1.5 to 9  $\mu\text{m}$ , or 1 to 10  $\text{g/m}^2$
- c) and c') a layer of a biaxially stretched polyamide of thickness

e.g. 20 to 50  $\mu\text{m}$ , preferably 20 to 40  $\mu\text{m}$  and in particular

20 to 30  $\mu\text{m}$

and if desired

d) and d') a barrier layer on one or both sides

and if desired

e) and/or e') a layer of a sealing coating or sealing layer on one or both sides in a quantity of 2 to 6  $\text{g/m}^2$ , or of thickness up to 10  $\mu\text{m}$ ."

\* \* \*

"Useful composite materials contain \*\*\*. \*\*\* Analogously, layers b), c), d) and e) are provided on one side of layer a) and layers b'), c'), d') and e') on the other side of layer a)." [Emphasis supplied]

Page 2100-120 of the M.P.E.P. states that a "prior art reference must be considered in its entirety, i.e., as a whole, \*\*\*." It is error for the Patent Office to take a sentence(s) out of context, particularly where such sentence(s), as here, refer to other sentences/paragraphs that clearly establish the context.

Lines 9 to 13 of column 4 of Breitler et al. states:

"The plastic layers on both sides of the metal layer, in particular the polyamide-based thermoplastics may additionally, and independent of each other, be provided with an outer lying sealable layer and/or a barrier layer of thermoplastics." [Emphasis supplied]

Such text is not discussing the plastic layers by themselves but instead only as components in the structure of the basic composite material. The use of the phrase “outer lying sealable layer” refers only to the outside surfaces of the basic composite material (i.e., the outside surface of each of the plastic layers). The words “outer lying” refer only to the side of each of the plastic layers away from the metal foil.

Furthermore, the above quotation also shows that the sealable layers were only located on the outside of the composite material on the outer side of the polyamide layers.

The phrase “on outer lying sealable layer and/or a barrier layer” restricts the sealable layer to the outside surface of the plastic layers in the composite material. The term “outer lying” does not modify the barrier layer.

When Breitler et al. meant that a substance or layer could be located between a plastic layer and the metal layer, the text clearly says or indicates so. Column 4, lines 46 to 61, of Breitler et al. states:

“Beside the metal foil, at least one additional layer may be provided as a barrier layer \*\*\*. \*\*\* Barrier layers are situated for example between the metal layer and the polyamide layer or layers; the barrier layers are preferably situated on the polyamide layer on the opposite side facing the metal layer.

Foreseen in particular is a barrier layer on one side of the metal layer only, lying on the polyamide layer.”

The above quotation recites that the barrier layer can be between one of the plastic layers and the metal foil. The term “outer lying” does not modify “a barrier layer”, but

instead restricts the location of the “sealable layer” to the outside surface of the plastic layer away from the metal foil.

The Examiner has insisted that there are two ways to interpret column 4 of Breitler et al. Section 102(b) requires facts. Therefore, while appellants disagree that there are two interpretations, the Examiner's assertion that she is using one of her interpretations shows that she is not relying upon facts (as required for proof of anticipation). Interpretation is not the same as facts.

The Office Action of February 24, 2003, states:

“...the Examiner's interpretation of Breitler et al....” [Emphasis supplied] [Page 3]

“...further notes that her interpretation **is consistent** with what is understood in the packaging art,....” [Emphasis supplied] [Page 4]

Similar or identical statements by the Examiner which show that she is relying on her interpretation of column 4 of Breitler et al. are found on page 3 of the 5/7/03 Advisory Action and on pages 2 and 3 of the 3/25/02 Office Action.

The Advisory Action of May 10, 2002 states:

“..., a fair reading of Breitler et al. by one having ordinary skill in the art would nevertheless lead one skilled in the art to the interpretation that a sealable or polypropylene layer can be provided on **either or both sides of each polyamide layer** independent of other layers.” [Emphasis supplied] [Page 2]

Facts are definitive. Interpretation is only speculation, particularly where as here the Examiner has asserted that there are two interpretations of column 4.



Appellants do not agree that there are any interpretations of column 4, let alone two ways to interpret column 4. Column 4 in itself, and in the context of all of Breitler et al., constitutes a definitive or factual disclosure that the sealable layer only lies outside of the polyamide layer. The Examiner's interpretation is speculation ungrounded in factual disclosure in Breitler et al.

The Office Action of February 24, 2003 states:

“ ‘Hence, given that the description at column 4, lines 36-44 can be interpreted both ways by one having ordinary skill in the art, the Examiner maintains her position that the Breitler et al reference serves as a teaching with regards to the instant invention.’ “ [Emphasis supplied] [Page 4]

Similar or identical statements by the Examiner are found on page 3 of the 5/7/03 Advisory Action and on page 2 of the 5/10/02 Advisory Action. Two ways to interpret a reference does not result in factual disclosure. Interpretation, let alone where two interpretations are admitted to by the Examiner, is not factual disclosure. Section 102(b) requires facts.

Webster's Ninth New Collegiate Dictionary (1989), states:

“interpret...1: to explain or tell the meaning of : present in understandable terms  
2 : to conceive in the light of individual belief, judgment, or circumstance:  
CONSTRUE” [Emphasis supplied] [Pages 632 and 633]

“in·ter·pre·ta·tion ...1 : the act or the result of interpreting : EXPLANATION”  
[Emphasis supplied] [Page 632]

“explain...1 a : to make known b : to make plain or understandable <footnotes

that ~ the terms> **2** : to give the reason for or cause of **3** : to show the logical development or relationships of ~ **vi** : to make something plain or understandable...”

“**syn EXPLAIN**, EXPOUND, EXPLICATE, ELUCIDATE, **INTERPRET** mean to make something clear or understandable. **EXPLAIN** implies a making plain or intelligible what is not immediately obvious or entirely known; EXPOUND implies a careful often elaborate explanation; EXPLICATE adds the idea of a developed or detailed analysis; ELUCIDATE stresses the throwing of light upon as by offering details or motives previously obscure or only implicit; **INTERPRET** adds to **EXPLAIN** the need for imagination or sympathy or special knowledge in dealing with something.” [Emphasis supplied] [Page 437]

Interpretation and explanation do not amount to facts. Webster’s Ninth New Collegiate Dictionary, ibid., states:

“fact...**3** : the quality of being actual; actuality ...**4 a**: something that has actual existence” [Page 444]

During the examination of Breitler et al., the Patent Office cited U.S. Patent No. 5,100,708 (Heyes et al.) against their underlying application. Heyes et al. disclosed a laminated metal sheet where the metal sheet had on one of its (major) surfaces a composite of an inner layer (A<sup>1</sup>) of thermoplastic polymer and an outer layer (B<sup>1</sup>) of thermoplastic polymer. Page 3 of the Office Action of March 5, 1996

therein stated: "The thickness of the inner and outer layer of the thermoplastic polymer \*\*\*." The Patent Office clearly was aware of that which was meant by "outer" or "outer laying" in the Breitler et al. application. Page 3 of the Amendment of October 13, 1995 stated: "In Heyes et al., the wording 'inner' means between the metal layer and the outer layer. Both the inner and outer layers are arranged on the same side of the metal sheet." The prosecution/examination history of Breitler clearly shows that the terms "outer" and "outer laying" do not mean between the metal foil and a polyamide layer.

Mr. Hans Breitler is the first-listed joint inventor in U.S. Patent No. 5,589,275 (Breitler et al.). During the proceedings in this application, the declaration of Mr. Breitler was filed. In his declaration, Mr. Breitler states that Breitler et al. discloses the barrier layers only being located on the outer or outside surface of the plastic layers (as opposed to the inner or inside surface) in the composite material, and that Breitler et al. did not include a polypropylene layer between either or both of the plastic layers and the metal layer.

Breitler et al. involves a composite material for the base part of blister packs for use in freeze drying applications for foodstuffs and pharmaceuticals. The basic structure of the composite material is a metal layer (foil) with a plastic layer on each side thereof. The plastic layers contain or comprise polyamide-based thermoplastics. Breitler et al. does not teach or suggest the inclusion of a polypropylene layer (or other sealing/sealable layer) between either or both of the plastic layers and the metal layer. The joint inventors of the composite material of Breitler et al. did not disclose or

contemplate that their involved invention included a polypropylene layer (or other sealing/sealable layer) between either or both of the plastic layers and the metal layer.

In his declaration, Mr. Breitler states that the text in lines 9 to 45 of column 4 of U.S. Patent No. 5,589,275 only refers to the optional presence of a sealing/sealable layer on the outside surface of either or both of the plastic layers in the composite material itself. Mr. Breitler further states that such text in column 4 does *not* refer, as such, to the presence of a sealing layer on one or both sides of either or both plastic layers separate from the basic structure of the composite.

In his declaration, Mr. Breitler states that there is *no* teaching of a sealing layer between either or both plastic layers and the metal layer (the basic composite material structure) in the text in lines 9 to 45 of column 4 of Breitler et al. Mr. Breitler also states that all references to sealing layers in such text in Breitler et al. are exclusively to sealing layers, located on the outer surfaces of the composite material, i.e., on the outer surface of the plastic layers of the composite material.

In his declaration, Mr. Breitler, referring to the text in lines 9 to 13 of column 4 of Breitler et al., states that such text is *not* discussing the plastic layers by themselves but only as components in the structure of the basic composite material; that the use of the phrase “outer lying sealable layer” refers only to the outside surfaces of the basic composite material (i.e., the outside surface of each of the plastic layers); and that the words “outer lying” refer only to the side of each of the plastic layers away from the metal foil. Mr. Breitler also states: that the phrase “on outer lying sealable layer and/or a barrier layer” restricts the sealable layer to the outside surface of the

plastic layers in the composite material; that the term “outer lying” does not modify the barrier layer; and that the term “outer lying” does not modify “a barrier layer”, but restricts the location of the “sealable layer” to the outside surface of the plastic layer away from the metal foil. Mr. Breitler further states: that, when the inventors meant that a substance or layer could be located between a plastic layer and the metal layer, the text of Breitler et al. clearly says or indicates so; see column 4, lines 46 to 61, of Breitler et al.; and that such text recites that the barrier layer can be between one of the plastic layers and the metal foil.

In his declaration, Mr. Breitler states: that in lines 36 to 45 of column 4 of Breitler et al. the text only discusses the basic composite material, placement of a sealable layer on the outer or outside surface of at least one of the plastic layers in the basic composite; and that such text does *not* refer to one or both sides of a plastic layer (in the composite material) having a sealable layer thereon – such is not part of the invention described in Breitler et al.

The purpose of the sealing layer in Breitler et al. is to facilitate affixing together container to the lid. The Breitler declaration states:

“The following information further shows that, in U.S. Patent No. 5,589,275, no sealing layer is arranged between the metal foil and the polyamide layer. The single purpose of the sealing layer of U.S. Patent No. 5,589,275 is to secure a lid on top of the base part of a packaging formed by the composite of said patent. Therefore, the sealing layer always forms the outermost layer of a base part made from the composite and the sealing layer

has a free surface. Depending on the kind of plastic film, the sealing layer is a necessity, otherwise it would not be possible to safely fix or seal the lid to the base part of a packaging. In other words, the sealing layer has to be exposed to the outside to meet the lid. This information is supported in U.S. Patent No. 5,589,275, at column 7, lines 44 to 47, column 7, lines 62 to 67 (another sealing layer having a free surface at the lid to meet the base part is mentioned), and column 8, lines 19 to 21." [Page 6]

The Breitler declaration clearly shows that it is incorrect to attribute to Breitler et al. any teaching of a sealing layer anywhere but as the outer layer of the composite.

There is no reason in the composite material of Breitler et al. to have an inner sealable layer (it already typically has an adhesive coating and/or bonding agent between the metal foil and the polyamide layer). The sealing layer of Breitler et al. is used only as the outermost layer for the purpose of safely fixing or sealing the lid to the base part of a packaging. The Examiner did not correctly read column 4 of Breitler et al. in view of such reference as a whole.

Walker, Albert H., "The Patent Laws", 3<sup>rd</sup> Ed., (1895), states:

"§ 75. Questions of novelty are questions of fact. This point is very obvious, except in cases where the prior thing is a patent or printed publication. In those cases it may be supposed that questions of novelty are questions of law arising on the construction of documents. The point has, however, been settled by the Supreme Court, in a case involving the consideration of a prior patent, ...

\*\*\*

The court accordingly indorsed the proposition that such questions belong to the province of evidence, and not to that of construction; and said that even where no testimony is required to explain the terms of art or the description contained in the respective documents, the question is still to be treated as a question of fact.” [Page 68]

The Examiner has the burden of proving that the Examiner’s reading of Breitler et al. is the only possible reading of such reference. Any prior art disclosure that can be read two or more ways does not establish the required factual basis. Appellants do not agree that there are two possible so-called interpretations of Breitler et al. The Examiner’s so-called interpretation of Breitler et al. is in error and unsupportable, as has shown above.

Walker, ibid., states:

“§ 76. The burden of proof of a want of novelty rests upon him who avers it, and every reasonable doubt should be resolved against him.” [Page 69]

The Examiner has not produced a sustainable or prima facie showing of anticipation supported by facts in the record. Hence, the anticipation rejection is fatally flawed. Breitler et al. does not teach all of the elements of the appellants’ claimed invention, as arranged in Claim 38.

Appellants request reversal of this anticipation rejection.

Claim 38 is patentable over independent Claim 51. Claim 38 requires that the second functional layer have in sequence of a first polypropylene layer, a polyamide layer and a second polypropylene. The coextruded polyamide-polypropylene film of Claim 51 does not suggest the inclusion of a second polypropylene film, particularly on the other side of the polyamide layer. Also, Claim 51 does not recite or suggest that the second function layer be directly bonded to the metal foil, as required by Claim 38. Breitler et al. does not supply disclosure or suggestion of the additional polypropylene layer, so there is no teaching or suggestion of the direct bonding (or via a bonding or adhesive layer).

Claim 38 is patentable over independent Claim 52 (and Claims 53 and 54). Claim 38 requires that the first polypropylene layer be directly bonded, or by means of a bonding agent layer or a laminate adhesive layer, to the metal foil. Claim 51 does not recite or suggest that the second functional layer be directly bonded to the metal foil, as required by Claim 38. Breitler et al. does not supply disclosure or suggestion of the additional propylene layer, so there is no teaching of suggestion of the direct bonding (or via a bonding or adhesive layer).

Regarding dependent Claims 39 to 45 and 47 to 50:

Dependent Claims 39 to 45 and 47 to 50 have been grouped with independent Claim 38. The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this anticipation rejection.



Regarding dependent Claim 46:

Dependent Claim 46 is not anticipated by Breitler et al. because Breitler et al. does not disclose a polypropylene layer between the metal foil and the polyamide layer.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this anticipation rejection.

Even if Claim 38 is unpatentable, Claim 46 is patentable over it because Claim 38 is not restricted to the second functional layer being a coextruded film of the three plastics. Breitler et al. does not teach the inner polypropylene layer.

Regarding Independent Claim 51:

Independent Claim 51 recites that second functional layer (c) is a plastic film consisting of a coextruded polyamide-polypropylene film. This claim is not anticipated by Breitler et al. because Breitler et al. does not disclose each and every element. Breitler et al. discloses metal foil, polyamide layer and polypropylene sequence; also Breitler et al. apparently does not show such two plastic layers in coextruded form. Claim 51 requires the presence of the sequence metal foil, polypropylene layer and polyamide layer, with the two plastic layers in coextruded form.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this anticipation rejection.

Independent Claim 51 recites that second functional layer (c) is a second plastic film consisting of a coextruded polyamide-polypropylene film. All of the other independent claims require that second functional layer (c) contain a plastic layer that is a layer comprising a (coextrusion-coated, coextruded and/or extrusion-laminated) film having a sequence of a first polypropylene layer, a polyamide layer and a second polypropylene layer; independent Claim 38 has further requirements for the direct or indirect bonding of the first polypropylene layer to metal foil (b). If Claim 51 is unpatentable, none of the other claims are unpatentable (anticipated) thereover.

Regarding independent Claim 52:

Independent Claim 52 requires that the second functional layer contains a film of a polypropylene layer, a polyamide layer and a polypropylene layer. This claim is not anticipated by Breitler et al. because Breitler et al. does not disclose each and every element. Breitler et al. discloses metal foil, polyamide layer and polypropylene. Breitler et al. does not show such three plastic layers in such sequence. Claim 52 requires the presence of the sequence metal foil, polypropylene layer, polyamide layer and polypropylene layers.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this anticipation rejection.

Independent Claim 52 recites that second functional layer (c) is a second plastic film that is a polypropylene-polyamide-polypropylene film. This claim is patentable over Claim 51 which does not include, or suggest, the second polypropylene layer.

Claim 51 is patentable over Claim 38 or Claim 46 or Claim 52, if either is held to be anticipated. Breitler does not teach the inclusion of the second polypropylene layer.

Regarding independent Claim 53 and dependent Claim 54:

Independent Claim 53 and dependent Claim 54 have been grouped with independent Claim 52. The discussion and information above concerning Claim 52 are incorporated herein.

Appellants request reversal of this anticipation rejection.

The Second Issue

The second issue is whether or not Claims 38 to 53 are unpatentable under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,589,275 (Breitler et al.) in view of Ullman's Encyclopedia of Industrial Chemistry (Ullman). Appellants assert that none of Claims 38 to 53 are obvious over such attempted combination of rejection references. Furthermore, the Examiner has not factually shown in the record that there is even motivation to combine the rejection references in the quest for appellants' claimed invention. As shown above, Breitler et al. does not disclose polypropylene (or other sealing layer) between the polyamide layer and the metal foil, so even if the two rejections are combined the result is not appellants' claimed invention.

Regarding independent Claim 38:

Section 2141 of the M.P.E.P. states:

"Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted

above, the four factual inquires enunciated therein as a back-ground for determining obviousness are as follows:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue;

(C) Resolving the level of ordinary skill in the pertinent art; and

(D) Evaluating the evidence of secondary considerations."

"The Supreme Court reaffirmed and relied upon the *Graham* three pronged test in its consideration and determination of obviousness in the fact situations presented in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, *reh'g denied*, 426 U.S. 955 (1976) and *Anferson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969). In each case, the Court discussed whether the claimed combinations produced a "new or different function" and a "synergistic result," but it clearly decided whether the claimed inventions were nonobviousness on the basis of the three-way test in *Graham*. Nowhere in its decisions in these cases does the Court state that the "new or different function" and "synergistic result" tests supersede a finding of nonobvious or obviousness under the *Graham* test."

"Accordingly, examiners should apply the test for patentability under 35 U.S.C. 103 set forth in *Graham*." [Emphasis supplied]

Page 2100-113 of the M.P.E.P. states:

**“STANDARD OF PATENTABILITY TO BE APPLIED IN OBVIOUSNESS REJECTIONS”**

“Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), ....”

“Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).”

The Examiner has not followed the dictated procedure and requirements of the Graham decision, therefore the Examiner has not even factually established in the record a prima facie showing obviousness.

The initial burden of presenting a prima facie case of obviousness rests on the Examiner. In re Oetiker, 24 USPQ2d 1443, 1444, (CAFC 1992). In determining whether an invention is obvious, the Examiner must consider: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art; and (4) any objective considerations that may be present. *Graham v. John Deere Co.*, 148 USPQ 459, 466 to 467, (Sp.Ct. 1966). “Where an obviousness determination is based upon a combination of prior art references, there must be some teaching, suggestion or incentive supporting the combination.” In re Geiger, 2 USPQ2d 1276, 1278, (CAFC 1987).

In order to prevent the impermissible use of hindsight, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cite prior art references for combination in the manner claimed.” In re Rouffet, 47 USPQ2d 1453, 1457 to 58, (CAFC 1998) (Emphasis supplied). It is not sufficient for the Examiner to rely on a high level of ordinary skill in the art to provide the motivation for combining the teachings of the cited references. See id. Rather the Examiner must explain “what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.” Id.

In the present case, the Examiner has merely identified where in the prior art the individual components of the claimed invention are supposedly taught and then incorrectly relied on his own explanation as to why it would have been obvious to have combined these components to achieve the claimed invention. See *Ecolochem, Inc. v. Southern California*, 227 F.3d 1361 (CAFC 2000) [quoting *In re Kotzab*, 55 USPQ2d 1313, 1317, (CAFC 2000)] (“[A] rejection cannot be predicated on the mere identification...of individual components of claimed limitations.”) At best, the Examiner has established that it might be “obvious to try”, which of course is of no importance under Section 103(a). See *In re Merck & Co., Inc.*, 231 USPQ 375, 379, (CAFC 1986).

The Examiner does not make reference to any teaching in the prior art which support the Examiner’s conclusion of obviousness. Rather, the Examiner has merely

stated that "it would have been obvious to have one ordinarily skilled in the art to determine". Reliance on "common knowledge and/or common sense does not fulfill the requirement to provide reasons to support in findings of obviousness. In re Thrift, 63 USPQ2d 2002, 2006, (CAFC 2002) [quoting In re Lee, 61 USPQ2d 1430, 1435, (CAFC 2002)].

Appellants have shown above that the disclosure of Breitler et al., including column 4 thereof, is that a sealable layer (polypropylene) is located on one or both sides of its composite material. Appellants have further show above that Breitler et al. does not disclose a sealable layer on both sides of a polyamide layer of its composite material. (Reference is made to the noted above discussion.)

The Examiner has not factually shown in the record that the composite of Breitler et al. contains a polyamide layer having a sealable layer (polypropylene) on both sides.

Lines 36 to 44 of column 4 of Breitler et al. does not refer to one or both sides of a plastic layer having a sealable layer thereon, but instead refers to a sealable layer on the outer or outside surface of at least one of the plastic layers in the basic composite.

The Examiner's interpretation of column 4 of Breitler et al. contains the basic mistakes of not taking the entire first sentence into consideration (for example, "A...composite...") and of taking portions out of context with the entire disclosure, object, etc., of Breitler et al.

The Examiner has advanced that she only relied on Ullman to support her statement that extrusion laminating, lamination coating via adhesives, and coextrusion

are conventional and well known methods of producing multilayer composite films and hence would have been obvious to one having ordinary skill in the art at the time of the invention. This does not meet the standard requirements of Section 103(a) including factual showing of motivation to combine Breitler et al. and Ullman in the search for applicants' claimed invention (where is the specific understanding or technical knowledge suggesting the combination). All of the disclosure of prior art of record must be considered under Section 103(a).

The CCPA in *Application Of Mercier*, 515 F.2d 1161, (1975), stated:

"The board's approach amounts, in substance, to nothing more than a hindsight 'reconstruction' of the claimed invention by relying on isolated teachings of the prior art without considering the over-all context within which those teachings are presented. Without the benefit of appellant's disclosure, a person having ordinary skill in the art would not know what portions of the disclosure of the reference to consider and what portions to disregard as irrelevant, or misleading. See *In re Wesslau*, 353 F.2d 238, 53 CCPA 746 (1965)." [Emphasis supplied] [Page 1166]

The CAFC in *Lubrizol Corp. v. Exxon Corp.*, 7 USPQ2d 1513, (1988), stated:

"Obviousness, however, cannot be established by combining the teachings of the prior art unless the prior art contains some teaching, suggestion or incentive which would have led one skilled in the art to combine the relevant teachings of those prior art references." [Page 1527]



The Examiner's interpretation of column 4 of Breitler et al. contains the basic mistakes of not taking the entire first sentence into consideration (for example, "A...composite...") and of taking portions out of context with the entire disclosure, object, etc., of Breitler et al.

The Examiner has advanced that she only relied on Ullman to support her statement that extrusion laminating, lamination coating via adhesives, and coextrusion are conventional and well known methods of producing multilayer composite films and hence would have been obvious to one having ordinary skill in the art at the time of the invention. This statement does not meet the requirements of Section 103(a) including factual showing of motivation to combine Breitler et al. and Ullman in the search for appellants' claimed invention (where is the specific understanding or technical knowledge suggesting the combination?). All of the disclosure or prior art of record must be considered under Section 103(a).

In order to prevent the impermissible use of hindsight, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." [Emphasis Supplied] In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner must explain "what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination." Id.

In the present case, the Examiner has merely identified where in the prior art the individual components of the claimed invention are taught and then relied on his own explanation as to why it would have been obvious to have combined these components to achieve the claimed invention. See Ecolochem, Inc. v. Southern California, 227 F.3d 1361, (Fed. Cir. 2000) (quoting In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)), (“[A] rejection cannot be predicated on the mere identification...of individual components of claimed limitations.”) At best, the Examiner has established that it might be “obvious to try”. See In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

The Examiner’s rejection is completely devoid of “particular findings” as to why one of ordinary skill in the art, with no knowledge of the claimed invention, would have used some of the teachings of Ullman in Breitler et al. in the search for appellants’ claimed invention. The Examiner has failed to identify any teaching or suggestion in the prior art which would have substituted any part of Ullman into Breitler et al. Furthermore, even if Breitler et al. and Ullman are combined, the result still is not appellants’ claimed invention.

The Examiner has further advanced that her interpretation is consistent with what is understood in the packaging art, note specifically, Muggli (U.S. Patent No. 5,968,663) that also utilizes the same language as the commonly assigned Breitler et al. and further exemplifies polyethylene/polypropylene “sealable layers” (c, c<sup>1</sup>, e and e<sup>1</sup>) on both sides of the plastic layers (d and d<sup>1</sup>), which are present on both sides of a central metal layer (a) (Abstract; Col. 3, line 42, to Col. 4, line 2; Col. 4, line 57 to 58).

Appellants traverse this statement. What language may be in Muggli is meaningless as to the disclosure of Breitler et al. – different inventions are involved. What counts is the disclosure of Breitler et al. The Breitler declaration establishes that the Examiner's interpretation of Breitler et al. is incorrect. Further note that Muggli does not use the location or position-restricting term "outer" or "outside".

Furthermore, there is the question of whether or not Muggli is part of this obviousness rejection. The Examiner has not provided any motivation for combining Muggli with the other two rejection references.

Section 103(a) requires facts, not speculation. As the Examiner stated on page 4 of the Office Action, she is relying on "her interpretation" and that Breitler et al. "can be interpreted in two ways". While applicants disagree that there are two ways to interpret Breitler et al., the Examiner has not established in the record anything but speculation. Choice between two so-called interpretations is certainly not the establishment of facts required by Section 103(a). The Examiner has not even shown or established factually in the record why one ordinarily skilled in the art has motivation or reason to choose her interpretation as opposed to any other interpretation. Of course, to even suggest that one can choose between two "interpretations" has nothing to do with the requirements of Section 103(a). The CAFC in *Lubrizol Corp v. Exxon Corp.*, ibid., stated:

"Nor may the claims of the patent in suit be used as a blueprint and abstracted individual teachings from the prior art references be used to create the invention of the patent in suit." [Page 1527]

This obviousness rejection is fatally defective. Furthermore, the Examiner has not factually established in the record any prima facie showing of obviousness.

Likewise, there is no mention of or resolution of the level of ordinary skill in the pertinent art, or mention of the facts to be used to make such resolution. The Examiner has not followed requirement (c) of the Graham decision. For this further reason, the obviousness rejection is fatally defective.

The Examiner has not followed the requirements of the Graham decision in making the obviousness rejection and therefore has not followed Office policy. The obviousness rejection is defective on its face.

The Examiner has not carried her burden of proof under Section 103(a). The Examiner has not produced a prima facie case of obviousness, so the burden of proof has not been shifted to appellants.

Appellants request reversal of this obviousness rejection.

Claim 38 is patentable over independent Claim 51 because Claim 38 requires that the first polypropylene layer be directly bonded, or by means of a bonding agent layer or laminate adhesive layer, to the metal foil. This feature is not required by claim 51. Claim 38 requires that the second functional layer have in sequence of a first polypropylene layer, a polyamide layer and a second polypropylene layer. Claim 51 only recites a coextruded polyamide-polypropylene film. Breittler et al. does not supply disclosure of suggestion of the additional polypropylene layer, so there is no teaching of the direct bonding (or via a bonding or adhesive layer).

Claim 38 is patentable over independent Claim 52 (and Claims 53 and 54) because Claim 38 requires that the first polypropylene layer be directly bonded, or by means of a bonding agent layer or laminate adhesive layer, to the metal foil. This feature is not required by Claim 52 (or Claim 53 or 54). Breitler et al. does not supply disclosure of the additional polypropylene layer, so there is also no teaching of the direct bonding (or via a bonding or adhesive layer).

Dependent Claim 46 is dependent on Claim 38, and is restricted to the three layers of the second functional layer being coextruded.

Dependent Claim 46 is dependent on Claim 38, and is restricted to the three layers of the second functional layer being coextruded.

Regarding dependent Claims 39 to 45 and 47 to 50:

Dependent Claims 39 to 45 and 47 to 50 have been grouped with independent Claim 38. The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this obviousness rejection.

Regarding dependent Claim 46:

Dependent Claim 46 is not obvious over Breitler et al. (in combination with Ullman) because Breitler et al. does not disclose or suggest a polypropylene layer between the metal foil and the polyamide layer. There is no motivation in Breitler et al. or Ullman to insert such polypropylene layer.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this anticipation rejection.

Even if Claim 38 is unpatentable, Claim 46 is patentable over it because Claim 38 is not restricted to the second functional layer being a coextruded film of the three plastics. Breitler et al. does not teach the inner polypropylene layer, or provide motivation to include it in such coextruded three-plastic film.

Regarding Independent Claim 51:

Independent Claim 51 recites that second functional layer (c) is a second plastic film consisting of a coextruded polyamide-polypropylene film. This claim is not obvious by Breitler et al. because Breitler et al. does not disclose or suggest appellants' claimed invention as a whole. Breitler et al. discloses metal foil, polyamide layer and polypropylene; also Breitler et al. apparently does not show such two plastic layers in coextruded form. Claim 51 requires the presence of the sequence metal foil, polypropylene layer and polyamide layer, with the two plastic layers in coextruded form.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this obviousness rejection.

Independent Claim 51 recites that second functional layer (c) is a second plastic film consisting of a coextruded polyamide-polypropylene film. All of the other independent claims require that second functional layer (c) contain a plastic layer that is a layer comprising a (coextrusion-coated, coextruded and/or extrusion-laminated) film having a sequence of a first polypropylene layer, a polyamide layer and a second

polypropylene layer; independent Claim 38 has further requirements for the direct or indirect bonding of the first polypropylene layer to metal foil (b). If Claim 51 is unpatentable, none of the other claims are obvious thereover (even with the presence of Breitler et al. and Ullman).

Regarding independent Claim 52:

Independent Claim 52 requires that the second functional layer contains a film of a polypropylene layer, a polyamide layer and a polypropylene layer. This claim is not suggested by Breitler et al. because Breitler et al. (even in combination with Ullman) does not disclose or suggest the second polypropylene layer (let alone in that sequence). Breitler et al. discloses metal foil, polyamide layer and polypropylene. Breitler et al. does not show or suggest such three plastic layers in such sequence. There is no prior art motivation to go to the sequence of metal foil, polypropylene layer, polyamide layer and polypropylene layers.

The discussion and information above concerning Claim 38 are incorporated herein.

Appellants request reversal of this obviousness rejection.

Independent Claim 52 recites that second functional layer (c) is a second plastic film that is a polypropylene-polyamide-polypropylene film. This claim is unpatentable over Claim 51 which does not include, or suggest, the second polypropylene layer. Claim 52 is patentable over Claim 38 or Claim 46, or Claim 52, if either is held to be obvious. Breitler et al. does not teach or suggest the inclusion of the second polypropylene layer-neither does Ullman.

Regarding independent Claim 53 and dependent Claim 54:

Independent Claim 53 and dependent Claim 54 have been grouped with independent Claim 52. The discussion and information above concerning Claim 52 are incorporated herein.

Appellants request reversal of this obviousness rejection.

**(9) APPENDIX**

Appendix (9), that contains a copy of the claims on appeal, is attached hereto.

**(10) MISCELLANEOUS MATTERS**

A check in the amount of \$330.00, for the fee required by 35 U.S.C. 41(a)(6)(B) for this brief in support of this appeal, is enclosed.

The Director of Patents is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 06-1110. A duplicate copy of this sheet is enclosed.

A request for an oral hearing before the Board Of Patent Appeals and Interferences, and a check for the fee required by 35 U.S.C. 41 (a)(6)(B, is being filed simultaneously herewith.

Appellants request reversal of the final rejections by the Examiner of Claims 38 to 53.



Respectfully submitted,

Oct. 24, 2003

Date

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## **(9) APPENDIX**

The following is a copy of the claims on appeal:

38. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer, the composite film having a layer structure containing one on top of the other in the following sequence:

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil having a thickness of 5 to 100  $\mu\text{m}$ ; and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer,

said first polypropylene is directly bonded to metal foil (b) or is bonded to metal foil (b) by means of a bonding agent layer or a laminate adhesive layer, and, optionally, a primer layer is on at least one surface of metal foil (b).

39. The sterilizable composite film according to Claim 38, wherein the second functional layer (c) comprises a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first bonding agent layer, a first polypropylene layer, a second bonding agent layer, a polyamide layer, a third bonding agent layer,

and a second polypropylene layer, the first bonding agent adhering together the metal foil (b) and the second functional layer (c).

40. The sterilizable composite film according to Claim 39, wherein the second functional layer (c) comprises a film having a sequence of a first bonding agent layer, a first polypropylene layer, a second bonding agent layer, a polyamide layer, a third bonding agent layer, and a second polypropylene layer, comprising extruded first bonding agent, laminated bonded first polypropylene, coextruded second bonding agent and polyamide, extruded third bonding agent, and laminated bonded second polypropylene, the first bonding agent adhering together the metal foil (b) and the second functional layer (c).

41. The sterilizable composite film according to Claim 40, wherein the second functional layer (c) comprises a film having a sequence of a first laminate adhesive layer, a first polypropylene layer, a second laminate adhesive layer, and a laminate bonded layered unit having a sequence of a polyamide layer, a bonding agent layer, and a polypropylene layer, the first laminate adhesive adhering together the metal foil (b) and the second functional layer (c).

42. The sterilizable composite film according to Claim 41, wherein the second functional layer (c) comprises a film having a sequence of a coextrusion-coated first bonding agent layer, a first polypropylene layer, a second bonding agent layer, a polyamide layer, a third bonding agent layer, and a second polypropylene layer, the first bonding agent adhering together the metal foil (b) and the second functional layer (c).

43. The sterilizable composite film according to Claim 39, wherein the second functional layer (c) comprises a film having a sequence of a first bonding agent layer, a first polypropylene layer with a thickness of 10 to 20  $\mu\text{m}$ , a second bonding agent layer with a thickness of 3 to 15  $\mu\text{m}$ , a polyamide layer with a thickness of 10 to 40  $\mu\text{m}$ , a third bonding agent layer with a thickness of 3 to 15  $\mu\text{m}$ , and a second polypropylene layer with a thickness of 30 to 70  $\mu\text{m}$ .

44. The sterilizable composite film according to Claim 39, wherein the second functional layer (c) comprises a film having a sequence of a first bonding agent layer, a polypropylene layer, an extruded second bonding agent layer, a laminated bonded polyamide layer, an extruded third bonding agent layer, and a laminated bonded polypropylene layer, the first bonding agent adhering together the metal foil (b) and the second functional layer (c).

45. The sterilizable composite film according to Claim 39, wherein the second functional layer (c) comprises a coextrusion-coated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer.

46. The sterilizable composite film according to Claim 38, wherein the second functional layer (c) comprises a coextruded film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer.

47. The sterilizable composite film according to Claim 38, wherein the second functional layer (c) comprises extrusion laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer.

48. The sterilizable composite film according to Claim 39, wherein, in the second functional layer (c), each bonding agent layer has a thickness of 0.5 to 15  $\mu\text{m}$ .

49. The sterilizable composite film according to Claim 41, wherein, in the second functional layer (c), each laminate adhesive layer is provided in an amount from 0.5 to 10  $\text{g/m}^2$ .

50. A pouch for packaging, made from the sterilizable composite film according to Claim 38.

51. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer, the composite film having a layer structure containing one on top of the other:

(a) a first functional layer containing a first plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil; and

(c) a second functional layer that is a second plastic film consisting of a coextruded polyamide-polypropylene film.

52. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer, the composite film having a layer structure containing one on top of the other in the following sequence:

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil having a thickness of 5 to 100  $\mu\text{m}$ ; and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second polypropylene layer.

53. A sterilizable composite film containing a barrier layer that is impermeable to water vapor and gases comprising a metal foil and on both sides of the barrier layer at least one functional layer, the composite film having a layer structure containing one on top of the other in the following sequence:

(a) a first functional layer containing a plastic film that is a polyester, a polyamide, or a polyolefin, or an extrusion layer of a polyolefin, or one or more lacquer layers, or print and lacquer layers, or print layers;

(b) a metal foil having a thickness of 5 to 100  $\mu\text{m}$ ; and

(c) a second functional layer containing a plastic layer that is a layer comprising a coextrusion-coated, a coextruded, and/or an extrusion-laminated film having a sequence of a first polypropylene layer, a polyamide layer, and a second nonstretched polypropylene layer.

54. The sterilizable composite film of Claim 53, wherein metal foil (b) is composed of aluminum that has been pretreated on both surfaces by corona

pretreatment, a primer layer, which is an epoxy resin or a polyurethane, on at least one surface, and has a thickness of 7 to 15  $\mu\text{m}$ , wherein the polyamide layer of second functional layer (c) is a polycaprolactam and has a thickness of 15 to 25  $\mu\text{m}$ , and the first functional layer (a) is a polyester film, a polyamide film or a polyolefin layer, and has a print layer on the outer surface thereof.